

REMARKS

Telephonic Examiner Interview Summary

Applicant's representative, patent attorney Brian D. Krell, conducted a telephonic interview with the Examiner on May 9, 2005. Mr. Krell and the Examiner discussed the prior art in relationship to applicant's claimed embodiments of the invention. More specifically, Mr. Krell noted that Bourdunis (U.S. Patent No. 2,809,476) may be interpreted as teaching the use of a *rigid* mounting flange 21 and a single flexible sanding pad 17. However, Bourdunis, individually or in combination with the other cited and applied references, fails to at least teach or suggest applicant's claimed embodiments having a first sanding pad made from a flexible or non-rigid material and a second sanding pad made from a flexible or non-rigid material, in combination with the other elements of the claims. Mr. Krell and Examiner came to agreement that the claims as amended above were allowable over the cited and applied references.

Information Disclosure Statement

Applicant respectfully notes that an Information Disclosure Statement was filed concurrently with the above-identified application. However, a copy of the Information Disclosure Statement was not returned to applicant with this Office Action nor with any of the previous Office Action indicating that the references were considered. Applicant encloses a copy of the originally filed Information Disclosure Statement herewith for the Examiner's convenience and a postcard receipt indicating receipt by the U.S. Patent and Trademark Office on June 25, 2003. Applicant respectfully requests that a copy of the Information Disclosure Statement be returned with all references considered initialed with the next communication to applicant.

Response to the Office Action

Claims 1-3, 5-26, and 28-36 are pending in the application. In an Office Action mailed March 25, 2005, the allowability of Claims 2, 4, 5-9, 13, 25, and 26 and the subject matter of

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

cancelled Claims 27 and 31 was withdrawn. Claims 1-3, 5-8, 10-13, and 24-36 were rejected under 35 U.S.C. § 103(a). Claims 14-23 were indicated as allowed. Claims 1, 24, and 34-36 have been amended as indicated above to clarify the invention. In view of the foregoing amendments and remarks that follow, applicant respectfully submits that the application is now in condition for allowance.

Rejection of Claims 1-3, 6, 8, 12, 13, 34, and 36 under 35 U.S.C. § 103(a)

Claims 1-3, 6, 8, 12, 13, 34, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,809,475, issued to Bourdunis (hereinafter the '476 patent") in view of U.S. Patent No. 2,489,005, also issued to Bourdunis (hereinafter the "'005 patent"). Applicant respectfully disagrees.

As is well known, the Office Action bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant asserts that neither the '476 patent or the '005 patent at least fail to teach or suggest, individually or in combination, "a frame adapted to couple to a sander having a first sanding pad made from a flexible material" and "a second sanding pad coupled to the frame, the second sanding pad made of a flexible material" as recited in Claim 1, and similarly recited in Claims 34 and 36, since the '476 patent or the '005 patent teach only the use of a single sanding pad made of a flexible or non-rigid material. Accordingly, applicants submit that neither the '476 patent or the '005 patent teach or suggest, individually or in combination, all the claim limitations of Claims 1, 34, and 36. Accordingly, applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of Claims 1, 34, and 36, and those claims which depend thereon, be withdrawn.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

Rejection of Claims 5 and 7 under 35 U.S.C. § 103(a)

Claims 5 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '476 patent in view of the '005 patent as applied to Claims 1 and 6, and further in view of U.S. Patent No. 2,447,518, issued to Marinsky (hereinafter the "518 patent").

Applicant respectfully disagrees. Claims 5 and 7 depend from independent Claim 1. For at least the same reasons argued above for Claim 1, dependent Claims 5 and 7 are allowable over the cited and applied references. Further, dependent Claims 5 and 7 are also submitted to be allowable because they include additional subject matter not taught or suggested by the cited and applied references, particularly when these recitations are considered in combination with the recitations of the claims from which they depend.

Rejection of Claims 10 and 11 under 35 U.S.C. § 103(a)

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '476 patent in view of the '005 patent as applied to Claim 1, and further in view of U.S. Patent No. 6,083,091, issued to Anderson (hereinafter the "091 patent").

Applicant respectfully disagrees. Claims 10 and 11 depend from independent Claim 1. For at least the same reasons argued above for Claim 1, dependent Claims 10 and 11 are allowable over the cited and applied references. Further, dependent Claims 10 and 11 are also submitted to be allowable because they include additional subject matter not taught or suggested by the cited and applied references, particularly when these recitations are considered in combination with the recitations of the claims from which they depend.

Rejection of Claims 24-31 and 35 under 35 U.S.C. § 103(a)

Claims 24-31 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '476 patent in view of the '005 patent and further in view of the '518 patent.

Applicant respectfully disagrees. As stated above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See*

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant asserts that the '476 patent, the '005 patent, and the '518 patent, at least fail to teach or suggest, individually or in combination, "a frame adapted to couple to a sander having a first sanding pad made from a non-rigid material" and "a second sanding pad coupled to the frame, the second sanding pad made from a non-rigid material" as recited in Claim 24, and as similarly recited in Claim 35, since the '476 patent, the '005 patent, and the '518 patent, teach only the use of a single sanding pad made of a flexible or non-rigid material. Accordingly, applicant submits that neither the '476 patent, the '005 patent, or the '518 patent teach or suggest, individually or in combination, all the claim limitations of Claims 24 and 35. Accordingly, applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of Claims 24 and 35, and those claims which depend thereon, be withdrawn.

Rejection of Claims 32 and 33 under 35 U.S.C. § 103(a)

Claims 32 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '476 patent in view of the '005 patent and further in view of the '518 patent as applied to Claim 24, and further in view of the '091 patent.

Applicant respectfully disagrees. Claims 32 and 33 depend from independent Claim 24. For at least the same reasons argued above for Claim 24, dependent Claims 32 and 33 are allowable over the cited and applied references. Further, dependent Claims 32 and 33 are also submitted to be allowable because they include additional subject matter not taught or suggested by the cited and applied references, particularly when these recitations are considered in combination with the recitations of the claims from which they depend.

///

///

///

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100



CONCLUSION

In view of the foregoing amendments and remarks, applicant respectfully submits that the present application is in condition for allowance. Reconsideration and reexamination of the application, as amended, and allowance of the claims at an early date are solicited. If the Examiner has any questions or comments concerning this matter, he is invited to contact applicant's attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}

Brian D. Krell
Registration No. 51,899
Direct Dial No. 206.695.1638

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: May 13, 2005

BDK:tmm

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100